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TRANSMITTAL LETTER
(General - Patent Pending)

AS JFW
Docket No.
OSSV-083441

Re Application Of: Shannon Morris

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/004,511	10/22/2001	Luan Kim Bui	30764	3728	

Title: METHOD AND APPARATUS FOR JEWELRY ORGANIZATION

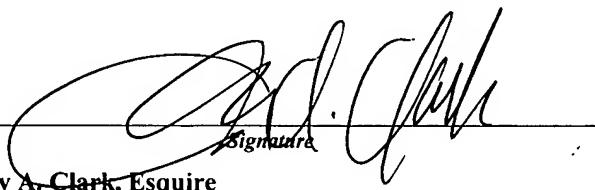
TO THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE:

Transmitted herewith is:

Reply Brief

in the above identified application.

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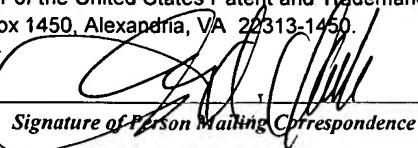


Signature

Dated: June 14, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/004,511
Applicant : Shannon Morris
Filed : October 22, 2001
TC/A.U. : 3728
Examiner : Luan Kim Bui

Docket No. : OSSV-083441
Customer No. : 30764

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits this reply brief under 37 C.F.R. § 1.193 to the amended and substitute *Examiner's Answer* mailed May 7, 2004 ("Amended Answer").

Preliminary Statement

The Examiner has submitted his *Amended Answer* apparently in response to the *Decision on Petition* mailed April 19, 2004. The *Decision on Petition* granted Applicant's petition requesting that prosecution on the merits be reopened. The ground for the petition was that the original *Examiner's Answer* mailed February 6, 2004 ("Original Answer") set forth a new ground of rejection. In the *Decision on Petition*, the Director agreed with Applicant, and the Examiner was clearly and unambiguously "instructed to withdraw the Examiner's Answer in favor of reopening prosecution." (Emphasis added.)

In his *Amended Answer*, the Examiner acknowledges the *Decision on Petition*. However, rather than comply with the *Decision on Petition* and afford Applicant a fair opportunity to address the new ground of rejection, the Examiner inexplicably has ignored the clear instruction to reopen prosecution. Instead in his *Amended Answer*, the Examiner has simply omitted the new ground of rejection. (*Amended Answer*, p. 2.) The *Amended Answer* now relies solely on an alternative ground of rejection set forth in the *Original Answer* – in which the Examiner hypothesizes the existence of an “oversized finger ring.” This was also a new ground for rejection in the *Original Answer*, but it is so lacking any basis in reality and illogical that Applicant saw no need to seek to reopen prosecution to address it.

The Examiner has offered no explanation or excuse for ignoring the *Decision on Petition*. Even more, the Examiner has neither explicitly withdrawn the new ground of rejection nor conceded that it was erroneous. Therefore, the Examiner has left Applicant little choice but to address the now-omitted new ground of rejection in this *Reply Brief* so that there is a written record in the prosecution history of Applicant's position. This is especially important because the Examiner's new ground of rejection, if not rebutted, might be argued as somehow applicable to Applicant's related U.S. Patent No. 6,334,530, which issued from the parent to the present application.

Independent claim 8 on appeal recites that the jewelry organizer includes a knob “having a diameter and height capable of receiving at least one finger ring over the knob.” In the *Original Answer*, the Examiner asserted for the first time that “(the word [over] is defined as In or at a position above or higher than; Upon the surface of; Above the top or surface; . . .” (*Original Answer*, p. 4.) Based on this definition, the Examiner attempted to justify his rejection of claim 8 with the following argument:

The knob of Grusin is inherently capable of receiving the at least one finger ring over the knob on the planar top surface since the claim as broadly recited read [sic] on the at least one finger ring placed on the planar top surface of the knob/over the knob [sic].

(*Id.*)

In constructing this argument, the Examiner ignored several facts. First, the word “over” has several additional definitions beyond those recited by the Examiner. Notably, one

such definition of “over” is “used as a function word to indicate position upon” See <http://www.m-w.com/cgi-bin/dictionary>. Second, the word “upon” is synonymous with the word “on.” See <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=upon>. Third, the definition of “ring” is “a circlet usually of precious metal worn on the finger.” See <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=ring> (emphasis added). Thus, for a finger ring to be received “on” or “over” a finger simply means that the finger has been received through the center of the ring in the ordinary manner.

The Examiner mistakenly seems to think that he can arbitrarily choose whatever dictionary definition he pleases for purposes of rejecting Applicant’s claims. However, as the Federal Circuit stated in Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002):

Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor. If more than one dictionary definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all such consistent meanings. The objective and contemporaneous record provided by the intrinsic evidence is the most reliable guide to help the court determine which of the possible meanings of the terms in question was intended by the inventor to particularly point out and distinctly claim the invention.

Id. at 1203 (citations omitted).

In this case, it is clear from the specification and drawings of the application that the knob recited in claim 8 is intended, in part, to serve a finger-like function in which one or more rings can be received over the knob, similar in manner to the way in which a ring is received over a finger. As stated in the specification,

In another aspect of the invention, the upper surface of the body has an upwardly protruding knob. The knob is approximately sized to the diameter of a finger for holding rings.

(Summary of the Invention, p. 3.) As further explained in the specification,

The jewelry organizer 10 has an upwardly protruding knob 28 for holding rings. . . . The knob is approximately sized to the diameter of a finger so that at least one ring can be stacked on it.

See also the relationship shown between the ring 18 and the knob 28 in Figure 1, in which the ring is received over the knob similar to the manner in which a ring is received over or on a finger.

At the same time, there is nothing in the specification to support the Examiner's position that the word "oyer" has been used by the Applicant in the sense of placing or positioning the ring "In or at a position above or higher than" the knob, or "Upon the surface of" the knob, or "Above the top or surface" of the knob. Nor has the Examiner pointed to anything in the specification or otherwise to support his position.

Accordingly, the Examiner's rejection of claims 8-11 based on his interpretation of the word "over" had no basis.

The Examiner's Hypothetical Of An "Oversized Finger Ring" Lacks Any Basis In Reality And Is Illogical

In the *Amended Answer*, the Examiner has withdrawn his rejection of claims 8-11 as allegedly anticipated by or obvious over U.S. Patent No. 2,036,572 to Frost. The Examiner has maintained his rejection of claims 8-11 as allegedly anticipated by U.S. Patent No. 5,040,681 to Grusin, stating for the first time that "the knob of Grusin is inherently capable of receiving an oversized finger ring over the knob." (*Amended Answer*, p. 5.)

The Examiner has not enlightened us with any explanation of what he means by "an oversized finger ring." As discussed in the preceding section, the ring is intended to be received over the knob, that is, the knob is intended to be received through the opening in the ring in a manner similar to the way a ring is received over a finger. Therefore, and considering that the Examiner has omitted his new ground of rejection based on the meaning of the word "over," the only thing the Examiner could be referring to is a ring with an oversized opening, i.e., an opening in the ring that is much larger than any finger over which the ring is intended to be received. Applicant knows of no such finger ring, and not surprisingly the Examiner has utterly failed to provide any example of one.

As carefully explained in *Appellant's Brief* (pp. 4-5), in order to render Grusin anticipatory, the ring would not just need to be somewhat oversized, the opening in the ring would have to be so large that it could be received over the knob 30 formed on the cover 18 of desk organizer in Grusin. As a matter of simple geometry, and as shown in Exhibit B to *Appellant's Brief*, such a finger ring would have to be enormously oversized to be received over the knob 30 of Grusin, such that the ring could never be worn as a finger ring by a human as a practical matter. Moreover, the Examiner ignores that if a giant existed with such an enormously oversized finger, then Grusin would have to enlarge his knob 30 and the aperture 54 through it to accommodate the giant's finger. A ring large enough to be received over that enlarged knob would, in turn, be too large to be worn as a finger ring by the giant. In other words, the Examiner's position not only lacks support in reality, it is utterly illogical.

Accordingly, the Examiner's after-the-fact attempt to justify his rejection of claims 8-11 on the basis that the knob 30 of Grusin could receive a hypothetical "oversized finger ring" should be dismissed.

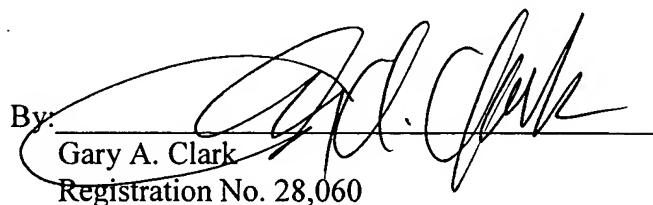
Conclusion

For all of the foregoing reasons, and those set forth in *Appellant's Brief*, the Examiner's rejection of claims 8-11 should be reversed and the application deemed allowable.

Dated: June 14, 2004

Respectfully Submitted,

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